



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,015	04/09/2001	Salim G. Kara	061135/P000C2CP1C1/101032	9558

29053 7590 04/23/2003

DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.
2200 ROSS AVENUE
SUITE 2800
DALLAS, TX 75201-2784

EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,015

Applicant(s)

KARA, SALIM G.

Examiner

Edward R. Cosimano

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.

2. The drawings are objected to because

A) the following errors have been noted in the drawings:

(1) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

(a) 901 in fig. 9 as disclosed in the paragraphs at page 40, lines 1-18, "Alternatively, the postage indicia ... window 901, in ... [new paragraph] ... window 901 in ... (such as inclement weather).".

(b) 1401A in fig. 14 as disclosed in the paragraph at page 63, lines 6-15, "In step 1403, the user ... is entered into the mail system of the shipping service provider in step 1401A.", (note the objection below).

(2) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

(a) 308 in fig. 3A in the paragraph at page 25, lines 13-25, "Referring to FIGURE 3A, there ... identified location for the user to sign. A ... PDF 417 code discussed in more detail below.".

(b) 1404A in fig. 14 in the paragraph at page 63, lines 6-15, "In step 1403, the user ... is entered into the mail system of the shipping service provider in step 1401A.", (note the objection below).

(3) fig. 8 does not depict the traffic light icon that is disclosed in the paragraph at page 40, lines 3-9, "If the check of Step 4 is ... the traffic light

Art Unit: 3629

icon which will also display "green" ... the traffic light displays "red" to indicate that a valid postage dispensing device was not detected."

2.1 A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2.2 Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

3. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the continuing data on page 1, and

(2) the application data on page(s) 1, 2, 29 (first full paragraph), 30 (second full paragraph), and 66 (second full paragraph);

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

B) as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:

(1) reference legend(s):

(a) 308 of fig. 3A in the paragraph at page 25, lines 13-25, "Referring to FIGURE 3A, there ... identified location for the user to sign. A ... PDF 417 code discussed in more detail below.";

(b) 1301 of fig. 13 in the paragraph at page 58, lines 1-5, "In step 1066, the ... routine. The internal layout of data in RAM for an agent (or mater) button is depicted in FIGURE 13."; and

(c) 1404A of fig. 14 in the paragraph at page 63, lines 6-15, "In step 1403, the user ... is entered into the mail system of the shipping service provider in step 1401A.", (note the objection below); and

(2) how the program proceeds after box(es):

(a) 1020 of fig. 10B if the inquiry is "YES" in the paragraph at page 50, lines 3-13, "Assuming that the button was ... or old, damaged button repair operations.";

(b) 1031 of fig. 10C if the inquiry is "NO" in the paragraph between page 50, line 14, and page 51, line 9, "The credit refill operation ... from the one described here below in FIGURE 6."; and

(c) 1034 of fig. 10C if the inquiry is "YES" in either of the paragraphs

(1) between page 50, line 14, and page 51, line 9, "The credit refill operation ... from the one described here below in FIGURE 6."; or

(2) at page 54, lines 10-13, "In step 1036 ... network. Box 1037 ends the routine.".

In this regard, it is noted that merely mentioning a number with out mentioning the device or operation of the step relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

C) the following errors have been noted in the specification:

(1) as can be seen in fig. 1A and from the context of the paragraphs:

(a) page 21, lines 8-16, "Referring to FIGURE 1A, there ... storage device 18, ... 11. Storage device 18 is ... a postage storage device receptor 17.";

(b) between page 24, line 25, and page 26, line 8, "After verifying the information ... coupled to printer 19 is ... TMU refilling stations or other authorized credit server."; and

(c) between page 30, line 25, and page 31, line 5, "With login successful ... button 19 into holder 17 ... prompted to retry the agent login operation.";

Art Unit: 3629

reference number 19 has been used twice to designate a printer and a button, therefore to be consistent with the remainder of the disclosure at line 3 of the paragraph between page 30, line 25, and page 31, line 5, "With login successful ... button 19 into holder 17 ... prompted to retry the agent login operation.", "19" should be --18--. Note the remainder of the disclosure, which consistently references device/button 18 and printer/maker 19.

(2) as can be seen in fig. 14 and from the context of the paragraph at page 63, lines 6-15, "In step 1403, the user ... is entered into the mail system of the shipping service provider in step 1401A.", at line 10 of this paragraph "1401A" should be --1404A--.

Appropriate correction is required.

4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

5. Claims 1-12 are rejected under the judicially created doctrine of double patenting over claims 1-47 of U. S. Patent No. 6,233,568 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

5.1 The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

A) determining transaction parameters;

B) using the determined parameters to rate an item to be shipped by a carrier for a plurality of carriers;

C) providing the rating results for comparison; and

D) based on the comparison picking a carrier.

5.2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

Art Unit: 3629

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

5.3 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

5.4 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6.1 Claims 1-7 & 9-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Piccione (4,495,581) or Barns-Slavin et al (5,117,346) or Theil (EP 0805422 or 5,699,258 or 6,035,291 or 6,321,214) in view of Berson et al (6,039,257).

Art Unit: 3629

6.1.1 In regard to claims 1-7 & 9-12, either Piccione ('581) or Barns-Slavin et al ('346) or Theil ('422 or '258 or '291 or '214), which disclose determining the lowest cost carrier for an item to be shipped based on user entered shipping transaction parameters.

6.1.2 Although these systems do not disclose printing an authorized indicia for the selected carrier in the environment of postage metering Berson et al ('257), which discloses using accounting information to generate a multidimensional barcode for the validation of a postage indicia. Such an indicia provided acceptable proof to the carries that the correct shipping charge has been paid by the user. Since, the carrier wants to be paid for services rendered to the user, it would have been obvious to one of ordinary skill at the time the invention was made that the shipping systems of either Piccione ('581) or Barns-Slavin et al ('346) or Theil ('422 or '258 or '291 or '214) could be modified to print an authorization indicia as taught by Berson et al ('257).

7. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) the prior art, for example:

(1) either Piccione (4,495,581) or Barns-Slavin et al (5,117,346) or Thiel (EP 0805422 or 5,699,258 or 6,035,291 or 6,321,214), which disclose determining the lowest cost carrier for an item to be shipped based on user entered shipping transaction parameters.

(2) Berson et al (6,039,257), which discloses using accounting information to generate a multidimensional barcode for the validation of a postage indicia.

B) however, in regard to claim 8, the prior art does not each or suggest that the shipping system may perform other functions, such as a word processor, database, spreadsheet or accounting.

8. The examiner has cited prior art of interest, for example:

A) Marien, which discloses that it is desirable to use the lowest cost carrier, and hence the cost for a number of carriers must be determined.

B) Freytag (5,490,077 or 5,602,743), which disclose using portable chip cards to hold postage accounting information or an user.

Art Unit: 3629

C) either Ramsden et al (5,656,799 or 5,831,220), which disclose a self contained shipping system that will determine the required shipping cost associated with a carrier that has been user selected from a number of carriers.

9. Prior art cited but not supplied herewith, has been supplied to applicant during the prosecution of the parent application.

10. The prior art cited in the parent applications has been considered by the examiner. Applicant wishes the remaining uncited prior art to appear on any patent that may mature from the instant application, then applicant should submit a properly completed PTO-1449 citing that prior art.

11. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

12.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

12.2 The fax phone number for OFFICIAL FAXES is (703) 305-7687.

12.3 The fax phone number for AFTER FINAL FAXES is (703) 308-3691.

04/19/03


Edward R. Cosimano
Primary Examiner A.U. 3629